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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,926	08/08/2006	G Eric Engstrom	109909-145059	4431

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EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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06/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,926	Applicant(s) ENGSTROM ET AL.	
	Examiner Erika A. Gary	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/23/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: on line 4, “successful” should be “successfully”. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 13-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14, 16, 18, and 19 of copending Application No. 10/550,925. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim essentially the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's submission of prior art, Kiyomoto, US Patent Application Publication Number 2002/0083329 (hereinafter Kiyomoto).

Regarding claims 1 and 7, Kiyomoto discloses a wireless mobile phone comprising: a plurality of components coupled to each other to facilitate wireless telephony communication by a user; a camera to facilitate real time taking of a photograph; and operating logic to receive the photograph and to operate the components depending on whether the user is successfully authenticated based at least in part on the photograph [paragraphs 0001, 0032, 0035, 0038, 0039, 0065-0067].

Regarding claims 2 and 8, Kiyomoto discloses the operating logic further comprises logic to compare the photograph against a reference photograph [paragraph 0065].

Regarding claims 3 and 9, Kiyomoto discloses the operating logic further comprises logic to save the photograph as a reference photograph for authentication [paragraphs 0065-0066].

Regarding claim 6, Kiyomoto discloses the photograph is a photograph selected from the photograph group consisting of a photograph of the user's face, a photograph of a body part of the user, a photograph of an article, and a photograph of an object [paragraph 0001].

6. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's submission of prior art, Pinault, US Patent Number 5,913,175 (hereinafter Pinault).

Regarding claims 13 and 15, Pinault discloses a wireless mobile phone comprising: a plurality of components coupled to each other to facilitate wireless telephony communication by a user, with the components being equipped to operate in at least a selected one of a first mode and a second mode; and operating logic to operate the components in said first mode without authentication of the user, and to operate the components in said second mode if the user is successfully authenticated based at least in part on an authentication reference retrieved from an identity card [abstract; col. 3: line 49 – col. 4: line 5; col. 7: lines 39-52].

Regarding claims 14 and 16, Pinault discloses the operating logic enables the components to provide first one or more functions while operating the components in said first mode, including retrieval of the authentication reference from the identity card,

and further enables the components to provide second additional one or more functions, while operating the components in said second mode [col. 3: line 49 – col. 4: line 5; col. 7: lines 39-52].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyomoto in view of Pinault.

Regarding claims 4 and 10, Kiyomoto does not specifically disclose the wireless mobile phone further comprises a reader to facilitate provision of a reference photograph via an identity card, for use to authenticate the user. However, Pinault teaches storing reference authentication information on an identity card [col. 7: lines 46-52].

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Kiyomoto to include Pinault. The motivation for this modification, as suggested by Pinault, would have been to store the reference authentication information on a separate device to provide different operating modes based on the level of authentication [col. 7: lines 39-52].

Regarding claims 5 and 11, Pinault discloses the reference photograph is stored in said identity card in a manner to be read by a reader selected from a reader group consisting of an electronic reader, an optical reader and a magnetic reader card [col. 7: lines 46-52].

Regarding claim 12, Kiyomoto discloses the photograph is a photograph selected from the photograph group consisting of a photograph of the user' face, a photograph of a body part of the user, a photograph of an article, and a photograph of an object [paragraph 0001].

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EAG/

June 5, 2008

/Erika A. Gary/

Primary Examiner, Art Unit 2617